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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,355	04/20/2001	Jay Yogeshwar	FPD-3	1837
26479	7590	10/24/2005	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			CHEVALIER, ROBERT	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,355

Applicant(s)

YOGESHWAR ET AL.

Examiner

Bob Chevalier

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-44 is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7,8,20 and 25-33 is/are rejected.
- 7) ☒ Claim(s) 2,3,6,9-19 and 21-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 25-33 are rejected under 35 U.S.C. 101 because the claim is directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 2616

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 4-5, 7-8, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al in view of the submitted prior art of Tan (EP 0912063 A2).

Lane et al discloses a video/audio recording/reproducing apparatus that shows substantially the same limitations recited in claims 1, and 20, including the feature decoding first encoded image data to generate first decoded image data (See Lane et al's column 50, lines 30-48, where it is disclosed that encoded image data are received and said received encoded image data are decoded), and the feature of storing the encoded image data on a digital storage medium as specified in the present claims 1, and 20. (See the capability of recording the encoded image data on the recording medium as shown in Lane et al's Figure 10a, components 308, and 340).

Although Lane et al discloses the capability of storing the image information on a storage medium, it is noted however, that Lane et al fails to specifically disclose the feature of analyzing the content of the first decoded image data to generate index information and storing the same together with the image on the storage medium as specified in the present claims 1, and 20.

It is further noted that, the submitted prior art of Tan (EP 0912063 A2) discloses the capability of analyzing the content of video information and generating index information which are inserted in a header area of the generated video packet for

transmission purposes as recited in claims 1, and 20. (See Tan's Figure 1, components 130 and 140, and further, see Tan's page 6, paragraphs [0045-0046]).

It would have been obvious to one skilled in the art to modify the Lane et al's recording/reproducing apparatus wherein the encoding means provided thereof would incorporate the capability of analyzing the content of the image data so as to generate index information and multiplexing the same with the encoded image data before providing the multiplexed data to the recording means for recording purposes. The motivation is to increase the quality of the image data at reproduction as suggested by Tan.

With regard to claim 4, the feature of receiving image data information prior to performing the encoding step and recording the same on the storage media as specified thereof would be inherently present in the proposed combination indicated above. Because, Lane et al already discloses in column 50, lines 41-48, and column 1, lines 1-5, that the data are depacketized and repacketized including the header information for recording purposes).

With regard to claim 5, the feature of recording the image data, index information in a first file on the storage medium as specified thereof would be present in the proposed combination indicated above. (See the capability of recording the image data including header information as trick play data on the recording medium as shown in Lane et al's Figure 13b).

With regard to claims 7-8, the feature of storing the first of encoded data with the first indexing information in a first file and storing the second set of encoded data with

Art Unit: 2616

the second indexing information in a second file on the storage medium as specified thereof would be inherently present in the proposed combination indicated above.

Since, Lane et al discloses in Figure 13b the capability of recording on the recording medium encoded data of the two different speeds wherein each speed can be interpreted as one file.

6. Claims 2-3, 6, 9-19, 21-24, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 34-44 contain allowable subject matter over the prior art of record.

8. The following is a statement of reasons for the indication of allowable subject matter:

The claimed invention is directed to a method of processing encoded data file. The independent claim identify the feature of "searching/retrieving the encoded data file for content information which can be obtained by examining encoded data included in said file without fully decoding said encoded data; and fully decoding the retrieved encoded data". The independent claim identifies the feature of "performing a partial decoding operation on retrieved encoded information to generate partially decoded data; and performing an indexing operation on the partially decoded data to generate indexing information". The closest prior art, Tan (EP 0912063 A2), discloses a transmission apparatus which includes the capability of generating index information, either singularly or in combination fails to anticipate or render the above underlined limitations obvious.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
September 17, 2005.


ROBERT CHEVALIER
PRIMARY EXAMINER